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REMARKS

Claims 1-6 are pending in the present application. Claims 1-6, the title, and the specification are amended by this amendment. No new matter is added by the amendments, which find support throughout the specification and figures. In view of the following remarks, favorable reconsideration of this application is respectfully requested.

The Examiner objects to Fig. 1 of the drawings as failing to describe the "non-volatile memory" and "security function" described on page 9, lines 6-7 of the specification. However, the specification clearly states that the device 201 has the non-volatile memory and security function. Further, page 10 of the specification also states that the IC chip 205 is given both a non-volatile memory and security function. It is respectfully submitted that both of elements 201 and 205 disclose a non-volatile memory and a security function, and therefore it is respectfully requested that the objection to the drawings be withdrawn.

The Examiner objects to the title as not being descriptive. Applicants herein submit a new title that describes with greater particularity the present invention. Therefore, it is respectfully requested that the objection to the title be withdrawn.

The Examiner also objects to page 10 and page 18 of the specification. These paragraphs are amended herein as suggested by the Examiner, and therefore it is respectfully requested that the objection to the specification be withdrawn.

Claims 2-6 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. These claims are amended as suggested by the Examiner, and therefore it is respectfully requested that the rejection of these claims be withdrawn.

Claims 1-4 and 6 are rejected under 35 U.S.C. § 102(b) as anticipated by Tanaka (U.S. 6,199,120). Applicants respectfully traverse.

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Claim 1 relates to *a storage device that is detachably attachable to an information processing apparatus*. The storage device of claim 1 includes, *inter alia*, an IC chip and *a first control unit extracting a control command for the IC chip included in a control command for the storage device from the information processing apparatus*. The storage device of claim 1 further includes a second control unit performing interface conversion corresponding to the IC chip on the control command for the IC chip extracted by the first control unit and giving the converted control command to the IC chip.

The present invention provides a storage device that is capable of controlling an IC chip included in the storage device, using a control command for the storage device, and without a dedicated driver for issuing a unique control command for each IC chip. The present invention includes the extracting of the control command for the IC chip from a control command for the storage device which is from an information processing apparatus.

In stark contrast, Tanaka apparently provides an IC card system for allowing use of multiple vendors in an IC card system. The invention of Tanaka includes an IC card R/W apparatus that generates an IC card command to possibly identify the maker of an IC card (Tanaka; figure 13, element 55).

The Examiner asserts that at least elements 2D and 3D of figure 4 disclose the storage device of claim 1. However, as is apparent from figure 4, as well as figure 6 and the accompanying description, the IC Card Reading/Writing Apparatus of Tanaka is not necessarily *detachably attachable* to an information processing apparatus. Figure 4 indicates that only the IC Card 1D is part of Card Body 11D. Similarly, figure 6 of Tanaka apparently discloses IC Card 4 and IC Card Reading/Writing Apparatus 6, and states:

In FIG. 6, numeral 4 denotes *an IC card*, numeral 5 denotes an IC card reading/writing apparatus (IC card R/W apparatus), numeral 6

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denotes an intelligent type IC card R/W apparatus, and numeral 7 denotes *a personal computer which is connected to the IC card R/W apparatus 5 or 6 as a host.*

(Tanaka; col. 17, lines 32-36; emphasis added). Similarly, Tanaka also discusses "*the IC card 4* having the above-described structure *is inserted* into the IC card R/W apparatus 5 or 6" (Tanaka; col. 17, lines 66-67; emphasis added). Therefore, it is apparent from Tanaka that the IC Card discussed therein may be detachably attachable, but there is no disclosure that the IC Card Reading/Writing Apparatus discussed therein is detachably attachable. Therefore, for at least this reason claim 1 is allowable.

Additionally, although the invention of Tanaka apparently generates an IC card command, the present invention *extracts the control command for the IC chip from a control command for the storage device which is from the information processing apparatus.*

According to the present invention, it is possible to use an IC chip built in the memory card using an information processing apparatus without using a dedicated driver for issuing a unique control command for each IC chip. The Examiner asserts that the IC Card R/W apparatus is analogous to the first control unit. However, there is no disclosure or suggestion in Tanaka that this R/W apparatus *extracts a control command for the storage device from the information processing apparatus.* The Examiner admits that Tanaka discusses generating an IC card command, but there is no description of extracting a control command for the IC chip included in a control command for the storage device from the information processing apparatus, as recited in claim 1. For at least the above reasons, Tanaka does not identically disclose or suggest all of the features of claim 1, and therefore claim 1 is allowable.

Claims 2-4 and 6 depend from claim 1 and are therefore allowable for at least the same reasons as claim 1 is allowable.

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Claim 5 is rejected under 35 U.S.C. § 103(a) as unpatentable over Tanaka in view of Nagamasa et al. (U.S. 2004/177215). Applicants respectfully traverse.


Claim 5 depends from claim 1 and is therefore allowable for at least the same reasons as claim 1 is allowable. Additionally, the Examiner asserts that the combination of Tanaka and Nagamasa is motivated "to provide a storage apparatus in which security is improved" (Office Action; page 8, lines 13-14). However, this appears to merely present a benefit claimed by Nagamasa, and does not present a proper motivation to combine the references. The Federal Circuit has held that there must be "findings as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of [the] invention to make the combination in the manner claimed." *In re Kotzab*, 217 F. 3d 1365, 1371 (Fed. Cir. 2000). The present rejection gives no suggestion as to why a practitioner in the art would have elected to combine Tanaka and Nagamasa, nor more particularly, *the manner* in which the two references should be combined. Therefore, the motivation to combine the references is insufficient to justify the combination, and therefore the rejection should be withdrawn.

In view of the remarks set forth above, this application is believed to be in condition for allowance which action is respectfully requested. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

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Respectfully submitted,

  
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